



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/853,650 | 05/14/2001 | Robert Ulrich | 001580-756 | 9450 |

7590 03/15/2004
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

LEWIS, ADAM M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2174

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,650

Applicant(s)

ULRICH ET AL.

Examiner

Adam M. Lewis

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 29-54 is/are rejected.
- 7) ☒ Claim(s) 55 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 29-31, 33-40, 42, and 44-52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-24 of prior U.S. Patent No. 6,297,818. This is a double patenting rejection.

The claim correspondence is as follows:

| | | | | | | | | | | | |
|----------------------------|----|----|----|----|----|----|----|----|----|----|----|
| Application No. 09/853,650 | 29 | 30 | 31 | 33 | 34 | 35 | 36 | 37 | 38 | 39 | 40 |
| US Patent # 6,297,818 | 1 | 1 | 2 | 4 | 5 | 6 | 7 | 8 | 9 | 10 | 11 |

| | | | | | | | | | | |
|----------------------------|----|----|----|----|----|----|----|----|----|----|
| Application No. 09/853,650 | 42 | 44 | 45 | 46 | 47 | 48 | 49 | 50 | 51 | 52 |
| US Patent # 6,297,818 | 14 | 16 | 17 | 18 | 19 | 20 | 21 | 22 | 23 | 24 |

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 2174

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 32 and 43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 15 respectively of U.S. Patent No. 6,297,818.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent defines a specific range of volume, whereas the application is open ended in its claims of variation of volume. The species claimed in the conflicting patent anticipates the claimed genus in the application being examined and therefore would extend the rights of the species should the genus issue as a patent after the species.

5. Claim 41 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,297,818.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent defines the limitations of receiving user-controlled output, and continuing the sound effect until the object has reached a second display position. The processor for controlling the speaker cited in claim 41 of the instant application is anticipated by the means for panning sound of claim 14 in the conflicting patent. The species claimed in the conflicting patent anticipates the claimed genus in the application being examined and therefore would extend the rights of the species should the genus issue as a patent after the species.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKiel, Jr. ("McKiel", US# 5,374,924) in view of Collier ("Collier", US# 6,964,837).

As per independent claim 53, McKiel teaches in a graphical user interface, a method for displaying sound effects comprising the steps of:

displaying an object in a first display state (McKiel, col. 3, line 42);

identifying a sound effect associated with a transition from a first display state to a second display state (McKiel, col. 3, lines 58-60);

varying an output characteristic of said sound effect (McKiel, col. 4, lines 8-12);

and

reproducing said sound effect using said varied output characteristic (McKiel, col. 4, lines 8-12).

McKiel fails to teach the step of identifying a sound effect using a state table.

However, Collier teaches a microprocessor, interconnected with detectors, that is responsive to the detection of the internal control signals for selectively sequencing through a state table of programmed sound effects (Collier, col. 3, lines 25-29).

Therefore it would have been obvious to one skilled in the art to include the state table sound identification of Collier in the sound effect system of McKiel because it

Art Unit: 2174

would provide a way to change the sound effects without having to change the program code.

As per claim 54, which is dependent on claim 53, McKiel further teaches the method of claim 53, wherein said output characteristic is frequency (McKiel, col. 4, lines 8-12).

Allowable Subject Matter

8. Claim 28 is allowed.

9. Claims 55 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for allowance:

The prior art of record fails to anticipate or make obvious the claimed invention.

Specifically, as per claim 28, the prior art fails to teach wholly, or in combination, the following elements:

a sound effect comprising:

a first sound segment for initiating said sound effect;

a second sound segment which is repeatable to sustain said sound effect; and

a third sound segment for decaying said sound effect;

wherein said first sound segment, said second sound segment and said third sound segment are associated with a transition between display states of a graphical user interface.

McKiel teaches a sound effect associated with a transition between display states of a graphical user interface, but does not disclose any type of multi-segmented sound. A multi-segmented sound for purposes of initiation, sustentation, and decaying is also unavailable in the searched prior art.

Specifically, as per claims 55 and 56, the prior art fails to teach, in combination with the remaining elements:

the method wherein the frequency is selected from within an envelope of about plus or minus 2.5 percent of an original, recorded frequency, as well as the selection being weighted towards the original, recorded frequency as cited in claims 55 and 56.

Although McKiel teaches a bounded frequency based on the movement of an on screen object, the range of frequency is quite large, on the order of plus or minus sixty percent. While the range claimed, about 2.5 percent, is certainly within the range of the reference, to use the reference range in substitution for the claimed range would destroy the utility of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Lewis whose telephone number is 703-305-0720. The examiner can normally be reached on M-Th 7:00-4:30, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

al

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100